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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/900,561	07/06/2001	Peter Bernard Kaars	US000171	5051

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Corporate Patent Counsel
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EXAMINER

PATEL, DHAIRYA A

ART UNIT	PAPER NUMBER
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2151

DATE MAILED: 08/26/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/900,561

Applicant(s)

KAARS, PETER BERNARD

Examiner

Dhairya A Patel

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 8/6/2001.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☐ Claim(s) _____ is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-10 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 16 August 2001 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date 3.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION

Application Number 09/900,561 was filed on 7/13/2000. Claims 1-10 are subject to examination.

Drawings

1. The drawings are objected to as failing to comply with 37 CFR 1.84(p)(5) because they include the following reference character(s) not mentioned in the description: 132. Corrected drawing sheets in compliance with 37 CFR 1.121(d), or amendment to the specification to add the reference character(s) in the description in compliance with 37 CFR 1.121(b) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The replacement sheet(s) should be labeled "Replacement Sheet" in the page header (as per 37 CFR 1.84(c)) so as not to obstruct any portion of the drawing figures. If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

Specification

2. The title of the invention is not descriptive. A new title is required that is clearly indicative of the invention to which the claims are directed.

The following title is suggested: EMAIL DISTRIBUTION USING EDGE SERVERS.

3. The specification is objected to because of the following informalities: Lack of Antecedent basis.

Appropriate correction is required.

In Column 2, paragraph 16 line 3 "edge Server" is not defined in the specification.

The applicant meant to say "Edge server". Appropriate correction is required.

Claim Rejections - 35 USC § 112

4. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

5. Claims 9, 10 rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.
6. As per claim 9, it is stating an electronic content with a list of addressees for receiving the content via a data network, where the list being based on the addressees being addressable through a specific edge server. The claim is indefinite because it is unclear whether the claim is directed to a method or to an apparatus. It is unclear how the claim contributes to accomplishing the goal of "receiving the content via a data network".
7. As per claim 10, it is stating software for, upon receipt of a combination of electronic content and a list of addressees, generating individual copies of the content for individual ones of the addressees. . The claim is indefinite because it is unclear whether the claim is directed to a method or to an apparatus. It is

unclear how the claim contributes to accomplishing the goal of "generating individual copies of the content for individual ones of the addressees".

Claim Rejections - 35 USC § 101

35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

8. Claims 9 and 10 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter where:
9. Claim 9 recites, "Electronic content with a list of addressees for receiving the content via a data network, the list being based on the addressees being addressable through a specific edge server" is non-statutory subject matter because "Electronic content with a list of addressees for receiving content" is only considered a recording medium and is absent computer readability or execution.
10. As per claim 10, "software for, upon receipt of a combination of electronic content and a list of addressees, generating individual copies of the content for individual ones of the addressees" it is claiming software which is considered non statutory. Software cannot be patented therefore it is non-statutory subject matter.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

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(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

11. Claims 1,2,4-6,8 rejected under 35 U.S.C. 102(e) as being anticipated by

Monsen et al. (hereinafter Monsen) (6,625,152).

12. As per claim 1, Monsen teaches a method of providing a service to enable to distribute electronic content (column 7 line 64 figure 1 (36)) via a data network (column 7 line 64 figure 1 (28)) to a plurality of addressees (column 7 line 64 figure 1 (30)), the method comprising:

- identifying respective servers (column 7 line 66 figure 1 (30)) via which to deliver the content to respective groups among the plurality of addressees; (column 7 line 65-67)

- sending one copy of the content to the respective server; and (column 7 line 65-67)

- enabling the respective server to send individual copies of the content to individual ones of the addressees in the respective group. (Column 7 lines 65-67, column 8 line1-2).

13. As per claim 2, Monsen teaches everything in claim 1, wherein the enabling to distribute comprises supplying a list of identifiers (figure 2 table 46) of the addressees of the respective group to the respective servers. (Column 9 lines 45-54).

14. As per claim 4, Monsen teaches everything in claim 1, wherein

- sending a first portion of the content (column 10 line2 figure 2 (36)) to the respective server; (column 10 lines 4-7).

-enabling the respective server to add a second portion (column 10 lines 8-9) to the first portion; and (column 10 lines 8-9).

-enabling the respective server to send the first and second portions to the individual addressees in the respective group. (Column 10 lines 31-35).

15. As per claims 5, it does not teach or further define over the limitations recited in claim 1. Therefore claim 5 is rejected under same basis as claim 1.

16. As per claims 6, it does not teach or further define over the limitation recited in claim 2. Therefore claim 6 is rejected under same basis as claim 2.

17. As per claims 8, it does not teach or further define over the limitation recited in claim 4. Therefore claim 8 is rejected under same basis as claim 4.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

18. Claims 3 and 7 are rejected under 35 U.S.C. 103(a) as being unpatentable over Monsen et al. (hereinafter Monsen) (6,625,152) in view of Shoujima et al. (hereinafter Shoujima)(5,754,778).

As per claim 3, Monsen teaches a method of providing a service to enable to distribute electronic content (column 7 line 64 figure 1 (36)) via a data network (column 7 line 64 figure 1 (28)) to a plurality of addressees (column 7 line 64 figure 1 (30)), the method comprising:

- identifying respective servers (column 7 line 66 figure 1 (30)) via which to deliver the content to respective groups among the plurality of addressees; (column 7 line 65-67)

- sending one copy of the content to the respective server; and (column 7 line 65-67)

- enabling the respective server to send individual copies of the content to individual ones of the addressees in the respective group. (Column 7 lines 65-67, column 8 lines 1-2).

Monsen fails to teach the content comprises e-mail.

Shoujima teaches content comprises an e-mail. (Column 10 lines 6-7). It would have been obvious to one of ordinary skill in the art at the time of applicant's invention to implement Monsen et al's content as an e-mail in order to send messages.

The motivation for doing would have been use content as e-mail (Column 10 lines 6-7) to send messages (such as text messages etc.).

As per Claim 7, Monsen teaches a method of distributing electronic content (column 7 line 64 figure 1 (36)) via a data network (column 7 line 64 figure 1 (28)) to a plurality of addressees (column 7 line 64 figure 1 (30)), the method comprising:

- identifying respective servers (column 7 line 66 figure 1 (30)) via which to deliver the content to respective groups among the plurality of addressees; (column 7 line 65-67)

-sending one copy of the content to the respective server; and (column7 line 65-67)

-enabling the respective server to send individual copies of the content to individual ones of the addressees in the respective group. (Column 7 line 65-67, column 8 lines1-2).

Monsen fails to teach the content comprises an e-mail.

Shoujima teaches content comprises an e-mail. (Column 10 lines 6-7). It would have been obvious to one of ordinary skill in the art at the time of applicant's invention to implement Monsen et al's content as an e-mail in order to send messages.

The motivation for doing would have been use content as e-mail (Column 10 lines 6-7) to send messages (such as text messages etc.).

Conclusion

20. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

"Client/server connection sharing", U.S. Patent # (5,553,242) by Russell, Edward A. et al.

"System for routing electronic mails" U.S. Patent # (5,765,033) by Miloslavsky, Alec.

21. A shortened statutory period for response to this action is set to expire **3 (three) months and 0 (zero) days** from the mail date of this letter. Failure to respond within the period for response will result in **ABANDONMENT** of the applicant (see 35 U.S.C 133, M.P.E.P 710.02, 710.02(b)).

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22.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Dhairya A Patel whose telephone number is 703-305-0457. The examiner can normally be reached on 8:30-5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Zarni Maung can be reached on 703-305-6687. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

DAP


ZARNI MAUNG
PRIMARY EXAMINER